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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,629	03/25/2004	Bizhan Karimi-Cherkandi	2003P07696 US	7485

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EXAMINER	
TRAN, QUOC DUC	

ART UNIT	PAPER NUMBER
2614	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/809,629	KARIMI-CHERKANDI ET AL.	
	Examiner	Art Unit	
	Quoc D. Tran	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in United Kingdom on 08/14/2003. It is noted, however, that applicant has not filed a certified copy of the 0319051.9, 0319048.5, 0319050.1 applications as required by 35 U.S.C. 119(b).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/809,618. Although the conflicting claims are not identical, they are not patentably distinct

from each other because claims 1-13 of the present application are similar in scope and/or broader than those of claims 1-12 with obvious wording variations. For example:

Regarding independent claims 1 and 10 of the present application, the copending application 10/809,618 claimed an apparatus and method for effecting a governmental regulation for monitoring a call in a telecommunications network, comprising: an application for executing commands that effect the governmental regulation; a primary rate interface (PRI) coupled to the application for redirecting calls to be monitored according to the governmental regulation; and a telephony protocol encapsulating the PRI for transporting signals relating to the call over a packetized network. Thus, claims 1 and 10 of the present application clearly covered by the claims of copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 8-10 and 12-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kampmeier et al (6,728,338).

Consider claims 1 and 10, Kampmeier et al teach a method and apparatus for monitoring a call in a telecommunications network in compliance with a governmental regulation (col. 1 lines 36-40, lines 50-52), comprising: an application for executing commands that effect the governmental regulation for monitoring the call (col. 2 line 65 – col. 3 line 12); and a primary rate interface (PRI) coupled to the application for redirecting calls to be monitored in compliance with governmental regulation (col. 3 lines 13-21; the PRI in inherent since call data channel 20 and call content channels (CCC) are dedicated channels connected to the Law Enforcement communication console, which inherently utilized via ISDN or T1).

Consider claim 2, Kampmeier et al teach wherein the PRI carries any calling ID and called ID, such that there is no indication to a caller of a redirection of the call (i.e., without disturbing) (col. 3 lines 22-39).

Consider claim 3, Kampmeier et al teach wherein the governmental regulation is established by the Communications Assistance for Law Enforcement Act (CALEA) (col. 1 lines 36-40, lines 50-52) .

Consider claims 4 and 12, Kampmeier et al teach wherein the PRI includes a B-Channel that conveys voice signals and the PRI loops the voice signals to a termination point (col. 3 lines 36-51).

Consider claims 5 and 13, Kampmeier et al teach wherein the PRI includes a D-Channel that conveys call data and the PRI forwards the call data to an operator (col. 3 lines 19-32).

Consider claim 6, Kampmeier et al teach wherein the PRI is a personal computer (PC) card (col. 3 lines 39-47).

Consider claims 8-9, col. 1 lines 27-34 read on the PSTN and the IP networks.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kampmeier et al (6,728,338) in view of Albers et al (6,229,887).

Consider claims 7 and 11, Kampmeier et al did not suggest the apparatus and method further comprising a Service Control Point that determines whether a particular call is to be regulated. However, Albers et al suggested such (col. 8 lines 33-49). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Albers et al into view of Kampmeier et al in order to trigger monitoring of the target call.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any response to this action should be mailed to:

Mail Stop ____(explanation, e.g., Amendment or After-final, etc.)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Facsimile responses should be faxed to:

(571) 273-8300

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Quoc Tran** whose telephone number is **(571) 272-7511**. The examiner can normally be reached on M, T, TH and Friday from 8:00 to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Curtis Kuntz**, can be reached on **(571) 272-7499**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600** whose telephone number is **(571) 272-2600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QUOC TRAN
PRIMARY EXAMINER

AU 2614
January 29, 2008